

### **REMARKS/ARGUMENTS**

Reconsideration of this application is respectfully requested in view of the foregoing amendments to the claims and the following remarks.

Status of the claims with the present application is as follows:

Rejected: Claims 1-59.

The examiner is thanked for the courtesy extended to the undersigned during a telephone interview conducted on May 9, 2005. During that interview the rejection of the independent claims were discussed. No agreement was reached during the interview. As more fully presented below, it was pointed out to the examiner that the patent used to reject claim 1 under 35 U.S.C. §102(b) does not show all the elements set out in claim 1. In particular, there is no tracking device disclosed by the cited patent. With regard to the rejections of claims 15, 28, 41, and 51 under 35 U.S.C. § 103(a), it was pointed out that these patents lack motivation for a person of ordinary skill to combine them as the examiner has done, as more fully set out below.

The amendment to claim 1 is for clarification to make it clear that the surgical navigation system can determine three dimensional locations. This language is well based in the specification where it indicates in multiple locations that the surgical navigation system is capable of determining the x, y, z coordinates of tracking devices. This represents three dimensions and therefore the amendment to Claim 1 clearly is not new matter.

The Examiner has rejected Claims 1-3, 6-8, and 13-14 under 35 U.S.C. §102(b) as anticipated by U. S. Patent No. 5,873,814 (Adair). This rejection as it applies to the claims now presented for examination, is respectfully traversed.

As briefly indicated above, Adair does not disclose either a surgical navigation system of the type as disclosed and claimed or tracking devices as set out in claim 1. The device as disclosed in Adair is not disclosed as used with a tracking device nor is the visual determination of location from the video camera a navigation system of the type as disclosed and claimed. Therefore, the rejection of Claims 1-3, 6-8, and 13-14 as anticipated by Adair is unwarranted and should be withdrawn.

The Examiner in the Official Action has also rejected Claims 4, 9-12, 15-17, and 19-27 under 35 U.S.C. § 103(a) as unpatentable over Adair in view of U. S. Patent No. 5,617,857 (Chader). This rejection is respectfully traversed.

Again, with regard to the rejected claim noted above, there is no disclosure or suggestion in either Adair or Chader that would provide motivation to one of ordinary skill in the art to combine these patents as the examiner has done. In particular, Adair discloses an endoscope device that operates using a video camera to provide a visual picture of a surgical or procedure site. Because of the visual nature of the endoscope it is logical that the display unit be conveniently located for the surgeon. The video of the end of the endoscope is what the surgeon is interested in seeing. There is no disclosure of a three dimensional navigation system or the use of a tracking device to locate the endoscope within the patient or surgical volume. The Chader patent discloses a smart instrument for use with a three dimensional surgical navigation system. However, there is no disclosure or suggestion to locate the display device in any location near or on the surgical tool. Because the systems used in Chader are more concerned with precision in the location of the tool, there was no thought to improving hand-eye coordination for the surgeon by placing the display on the tool itself. This rejection appears no longer warranted and should be withdrawn.

In addition, the Examiner has rejected Claims 28-30, 32-43, and 45-59 under 35 U.S.C. § 103(a) as unpatentable over U. S. Patent No. 5,408,409 (Glassman) in view of Adair. The rejection is respectfully traversed.

Because of the nature of a robotic surgical system, there is no reason to combine the documents as the examiner has done. A person of ordinary skill in the art would understand that a robotic system is programmed to perform certain actions and the display is there for a surgeon and/or technician to monitor the progress of the procedure. There is no hand-eye coordination needed with a robotic system and there would be no motivation to locate the display on the robotic tool as there is no need for an in line view of the display and the tool in this type of system. At least for this reason, the continued rejection of claims 28-30, 32-43, and 45-59 as obvious based on a combination of Glassman and Adair is unwarranted and should be withdrawn.

Lastly, the examiner has rejected claims 5, 18, 31, and 44 under 35 U.S.C. § 103(a) as unpatentable either based on Adair, and Chader combined with US Publication 2003/0078494

(Panescu), Chader combined with Panescu, or Glassman, and Adair combined with Panescu. These rejections are respectfully traversed.

Panescu does not remove the inherent deficiencies of the Chader, Adain and/or Glassman patents. While Panescu does disclose an LED display, it does so within a very different environment. It would not have been obvious to one of skill in the art to have combined these various patents and publications as the examiner has done. Therefore, the rejection of claims 5, 18, 31, and 44 should be withdrawn.

It is respectfully contended that the instant application has now been placed in immediate condition for allowance. Such action at an early date is earnestly solicited.

The Examiner is invited to telephone the undersigned Attorney if there is a need to resolve any remaining issues.

Respectfully submitted,

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